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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,203	06/15/2001	Leonard R. Bayer	HAR-003	8016

7590 08/08/2006
Kenneth J. LuKacher
South Winton Court
3136 Winton Road South, Suite 304
Rochester, NY 14623

EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/882,203	Applicant(s) BAYER ET AL.	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-29, 40 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29, 40 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The examiner for this application has changed. Please indicate Examiner James Kramer as the examiner of record in all future correspondences.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-29 and 44 are rejected under 35 U.S.C. 101 because they lack a tangible result.

With respect to claims 25-29 Examiner finds these claims to lack a tangible result.

Examiner begins by noting that the focus of this analysis is on the result, not the individual steps.

With that in mind in order to be considered tangible the process must produce a real-world result.

The final step of independent claim 25 states, “determining at least one of new product, product configuration, pricing or segmentation in accordance with said information.” This step does not produce a real-world result as the mere act of determining can be done in the mind or in a computer processor with no external effect.

Examiner notes here that claim 40, which depends from claim 25, includes the further step of “sending a survey” which the Examiner considers to be a tangible result. As such claim 40 is not rejected under 35 USC 101.

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With respect to claim 44, Examiner begins by noting that independent claim 42 (from which claim 44 depends) includes the resulting step of “returning information.” Examiner finds this step to be tangible. However, claim 44 includes the further step of “measuring elapse time for each user of the computer systems to configure the product.” This “measuring” step does not have a real-world effect and therefore is found to lack a tangible result.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-29, 40, and 42-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamlin et al in view of “How to Design and Implement Successful Pricing Research” by Susan Schwartz McDonald (hereinafter McDonald).

Hamlin teaches sending market research software from a network addressable site, via a network, to one or more computer systems (see for example column 2, lines 60-61).

Hamlin further teaches returning information via said network to said network addressable site having data representing at least said features selected (see for example column 2, lines 61-63).

Examiner would also like to point to the “Background of the Invention” section, in which Hamlin teaches,

“To obtain the requested information, individuals within research groups typically perform a series of linked steps. For example these steps may include:

- (1) working with the client to define the problem
- (2) designing a research instrument (i.e. a survey)
- (3) creating the research instrument (writing/producing the survey)
- (4) fielding the instrument using mail, telephone, in person or Internet-based media
- (5) processing the data obtained and analyzing the results and
- (6) generating a report of findings for the client”

It is the position of the Examiner that Hamlin teaches developing marketing research instruments/software (e.g. Internet surveys) to allow clients to get a better understanding of the market place. Hamlin does not specifically teach that the marketing instruments are used to determine a price value in accordance with selected features of a product.

McDonald teaches conjoint analysis in pricing research. Specifically McDonald teaches conjoint analysis as useful when a product is undefined and a client needs to solicit pricing judgments for a series of hypothetical product designs. (see page 8, 1st column, last paragraph). McDonald goes on to explain that conjoint design price is treated as one of several demand drivers and utilities are developed for each variable including price. Further conjoint analysis treats products as bundles of attributes which can be systematically manipulated. Respondents are asked to rate various permutations, or product bundles, and then clients are able to draw inferences about the importance of each attribute, as well as the appeal of each attribute (see page 10, 1st column).

McDonald further teaches that a nice features of conjoint analysis is in support of new product design efforts and its capacity to simulate demand for attribute bundles (see page 10, 1st column, last 4 lines).

Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to develop the marketing instruments of Hamlin in view of conjoint analysis to therefore create marketing research software that presents attribute bundles with a price (total price value and updating the total price value in accordance with changes in said selected features). One of ordinary skill in the art would have been motivated to make the above described modification in order to utilized the features of conjoint analysis (i.e. its support of new product design efforts and its capacity to simulate demand for attribute bundles) as taught by McDonald.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Kramer
Examiner
Art Unit 3627



7/28/06

jak